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Christopher Pasqualino

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MCANDREWS HELD & MALLOY, LTD
500 WEST MADISON STREET
SUITE 3400
CHICAGO, IL 60661

EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/034,414
Filing Date: December 27, 2001
Appellant(s): PASQUALINO, CHRISTOPHER

Mirut P. Dalal
Registration No. 44,052
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 11, 2008 appealing from the Office action mailed March 21, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2002/0186322 A1	Mair et al.	12-2002
60/296924	Mair et al.	06-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Mair et al. (US Patent Application Publication no. 2002/0186322 A1).

Regarding claims 1, 12 and 13, Mair discloses the same method of transmitting auxiliary data in video encoding (See Abstract) comprising receiving first and second data (See

[0042], lines 4-6), encoding the first data based on a state of at least one bit of the second data (See [0033], lines 7-19 and [0035, lines 7-16) , packaging the encoded first data and the second data into a single word (See [0042]), and communicating the single word (See [0043]).

As per claim 18, the limitations of this claim are met in the rejection of claims 1, 2 and 13 above.

As per claim 2, Mair further discloses the same method comprising DC balancing the first data (See [0021, lines 10-19).

As per claim 3, Mair further discloses the same method wherein the first data further comprises determining whether the first data should be inverted (See Mair [0038], lines 5-9).

As per claim 4, Mair further discloses the same method wherein encoding the first data further comparing a state of inversion of the first data to the state of the at least one bit of the second data (See [0038], lines 20-32).

As per claims 5-6, Mair further discloses inversion according to a matching criteria (See [0038], lines 5-34).

As per claims 7-11, most of the limitations of these claims have been noted in the above rejection of claim 1. In addition, the intermediate value being the audio data is disclosed in Mair [0021 and 0041].

As per claims 14-17, most of the limitations of these claims have been noted in the above rejection of claims 13. In addition, the step of performing the different logic operations as claimed is met in fig. 3B and in [0038].

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mair et al. (US Patent Application Publication no. 2002/0186322 A1).

As per claims 19-21, most of the limitations of these claims have been noted in the above rejection of claims 1, 12 and 13.

It is noted that while Mair provides the encoding and decoding in figs. 3A, 3B and 5, it is silent about the enhanced and un-enhanced aspect of the coding/decoding process. However, from paragraphs [0041 to paragraph 0044] Mair discloses several

encoding and decoding techniques wherein the encoding is performed with modulation, and the receiver/decoder receives the data without being encoded in [0044], and the receiver/decoder may send recovered auxiliary data to generate data path based on the accuracy of the auxiliary data. These steps are considered either equivalent or render the enhanced and un-enhanced encoding/decoding obvious to one skilled in the art since the purpose of using enhanced/or un-enhanced decoder/encoder is to transmit the auxiliary data without prior knowledge of the capability of the video received receiving auxiliary data as suggested by Mair in [0044].

(10) Response to Arguments

Regarding claim 1, the appellant argues that claim 1 cannot be rejected under 35 U.S.C. § 102(b). The appellant further indicated that it appears that the examiner meant to reject claim 1 under section (e) of 35 U.S.C. 102.

In response to the above arguments, the examiner wishes to thank the appellant for pointing the typographical error out. In fact, the examiner intended to correct the 35 U.S.C. 102 (b) to 35 U.S.C. 102 (e) while replying to the appellant's response to the non-final office action. The appellant should note that the typographical error was corrected above as the Ground(s) of rejection is repeated above.

The above response is also made with respect to similar arguments presented by the appellant regarding claims 12, 13, 18 and 19.

The appellant further argues that claim 1 cannot be rejected under 35 U.S.C. 102 (e) because Mair is not prior art under 102 (e). As arguments, the appellant notes that Mair was filed on October 15, 2001 and claims priority to provisional application Serial no. 60/296,924 filed June 8, 2001. In particular the appellant states that "the '924 Application does not properly support the subject matter relied upon to make the rejection in compliance with 35 U.S.C. first paragraph".

The above response is also made with respect to similar arguments presented by the appellant regarding claims 12, 13, 18 and 19.

The examiner respectfully disagrees. The provisional application, while it may appear to the appellant as a paper or proposal. The proposal submitted on the provisional application contains the elements to meet the 35 U.S.C. 112 first criteria.

The provisional application notes in the introduction that The DVI signal perform the encoding **while two additional bits perform specific and distinct functions** (See Introduction of the Provisional Application). The first and second functions of bits 8 and 9 in addition to the fact that DC balancing will be used to transport audio information are important in considering the proposal. The elements of the Abstract in the Application of Mair et al. (i.e., Publication no. 2002/0186322 A1) are proposed in the Introduction of the provisional. In addition, the "Principle of Operation" as well as in the section named "Proposal" of the provisional application '924 were considered by the examiner while testing for compliance with 35 U.S.C first paragraph. Considering the fact that the

elements of the abstract of Mair's Publication (2002/0186322 A1) are found in the proposal (which is the '924 provisional application), it is clear to the examiner that one skilled in the art can and would look to the provisional application to derive the Abstract as well as to find the claimed limitations of the current application.

The above response is also made with respect to similar arguments presented by the appellant regarding claims 12, 13, 18 and 19.

The appellant further argues that even if Mair is afforded the filing date of the '924 provisional application, the rejection should be reverse because Mair does not disclose "encoding the first data based on a state of at least one bit of the second data" as recited in claim 1.

The examiner respectfully disagrees. In the "Introduction" of the provisional application Mair clearly discloses "performing an 8B/10B encoding for the data being sent...".

Below is the introduction of the '924 provisional application:

Introduction

The DVI signaling method performs an 8B/10B encoding for the data being sent on the link. The two additional bits perform specific and distinct functions:

1) Bit 8 is used to indicate a transition that the data may go through for the purpose of transition minimization. If the number of transitions (0-> 1, or 1->0) is greater than 4, then the absence of a transition is encoded. In this way the number of transition in the sent word will always be less than or equal to 4.

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2) Bit 9 is used to indicate the optional inversion of bits 0 through 7. This inversion is used to ensure that during the transmission of active video, the number of logic 1 and logic 0 bits sent remains approximately the same.

This proposal is to use some of the DC balancing bits to transport the audio information over the link in a manner that does not change the data recovered by either a DVI-CE receiver, or a legacy receiver (installed base). DC balancing must also be maintained albeit with some minor differences.

Here in considering meeting the limitations of claim 1 the examiner first considered the **8B/10B** where the first data word is "8B" (i.e., bits 0...7); and the second data word is (8 or 9; or 8 & 9) as disclosed in 1) and 2) above. The combination is packaged into a single word.

The appellant further argues that Mair discloses that the 8 bit is used to indicate a translation that the data may go through for the purpose of transition minimization ...however, Mair neither bit 8 nor bit 9 is used by Mair for encoding any data. The examiner respectfully disagrees since the "Introduction" of Mair in the '924 provisional clearly qualifies the bit 8 and bit 9 for encoding purposes (See lines 1-2 of Introduction). Also (See 1) and 2) to see how and when the 8 bit and 9 bit are used).

The appellant further argues that the fact that "the elements of the abstract of Mair Publication (2002/0186322 A1) are found in the proposal (which is the provisional application)" is simply not proper standard for determining whether the "critical reference data of" Mair is the filing data of the provisional application".

The examiner respectfully disagrees. In determining the "invalidity" of Mair '924 as an acceptable provisional application, the appellant did consider the disclosure of such proposal. It is only fair for the examiner in reviewing provisional applicant '924 to present a section of Mair's publication (2002/0186322 A1) that correspond to the provisional application for support. It is not understood why it is not proper when determining whether the "critical reference date" of Mair is the filing date of the provisional application.

The above response is also made with respect to similar arguments presented by the appellant regarding claims 12, 13, 18 and 19.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/G. S. P./
/Gims S Philippe/
Primary Examiner, Art Unit 2621

Conferees:

Thai Tran: Supervisory Primary Examiner

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621.

Mehrdad Dastouri: Supervisory Primary Examiner

/Mehrdad Dastouri/

Supervisory Patent Examiner, Art Unit 2621